

REMARKS

I. Status of Claims

Prior to entry of this paper, **Claims 1-30** were pending. In the final Office Action issued February 3, 2009, Claims 1-30 were rejected. In this paper, Claims 1, 12, 21, and 30 are amended; no claims are cancelled or added. Claims 1-30 are currently pending. No new matter is added by way of this amendment. For at least the following reasons, applicants' representative respectfully submits that each of the presently pending claims is in condition for allowance.

Entry of the following response is respectfully requested at least because it places the application in better form for appeal.

II. Claim Rejections - 35 U.S.C. § 112

Claims 1-30 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In presenting the grounds of rejection, the most recent Office Action, at page 3, section 6, states, "*As per claims 1, 12, 21, and 30, the claim limitation is not clearly explained whether the client system or the message system, i.e. the sender server or the sender MTA, performs the disablement function...*"). The applicants' representative respectfully disagrees with this statement and rejection for a number of reasons.

First, it is noted that the rejected claims, including as they are amended herein, do not recite a "sender server" or a "sender MTA". Though not the focus of the above rejection, the applicant's representative disagrees with this implicit characterization of claim elements and reserves the right to further refute this association in subsequent responses.

Further, it is not necessary for the requested explanation of 'which system performs disablement' to be recited in the rejected claims in order for the inventions therein to be distinctly claimed, including as is required under 35 U.S.C. § 112, 2nd paragraph. For example, even without such an 'explanation', the Office Action was able to name at least two systems that may be involved with such a function. Limiting the cited function to either such system, as proposed in the explanation of the rejection, would unduly and unnecessarily restrict the scope of the amended

independent claims. More importantly, such an explanation does not appear to be necessary to overcome the prior art of record.

So far as amended independent Claims 1, 12, 21, and 30 respectively recite “*disabling*” or “*enabling a disablement of the client's outbound message usage*”, it is respectfully submitted that these claims, as well as the claims that depend therefrom, distinctly claim the subject matter as is necessary to inform public of the boundaries for which protection is sought (See MPEP §2173.02).

Accordingly, withdrawal of the rejections under 35 U.S.C. § 112, 2nd paragraph, is respectfully requested.

III. Claim Rejections - 35 U.S.C. § 103

Claims 1-3, 5, 7, 9-14, 16, 18-23, 25 and 27-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al., U.S. Patent No. 7,380,126 (hereinafter “Logan”) in view of Rhodes, U.S. Patent Publication No. 2003/0220978 (hereinafter “Rhodes”) in view of Bandini et al., U.S. Patent Publication No. 2002/0169954 (hereinafter “Bandini”).

With this paper, independent claims have been amended to further clarify the grounds of distinction, and thus, patentability, between the prior art of record and the inventions respectively claimed therein.

For example, independent **Claim 1**, as amended, at least recites:

wherein disabling the client's outbound message usage further includes disabling an operable ability of the client to send the composed message to the messaging system for sending to each recipient

Support for this amendment can be found throughout the application as originally filed, including on page 3, lines 17-20 and page 6, lines 22-25, and page 8, lines 10-20 and page 9, lines 4-6 and page 10, lines 14-20 of the specification.

Rather than the above limitation, Logan and Rhodes appear to merely disclose filtering or challenging a message once it has been received at a recipient's location or mail server (see col. 1, lines 61-65 and col. 4, lines 22-33 of Logan and para. [0031, 0034] of Rhodes). As previously noted, these disclosures of Logan and Rhodes do not disclose disabling a “*client's outbound*”

message usage”, much less the limitations that are further claimed in amended independent Claim 1. The most recent Office Action, at page 5, lines 8-13, appears to support this position.

However, the disclosure of Bandini does not cure this deficiency.

Instead, Bandini appears to somewhat disclose an email firewall 105 that may perform operations “in response to a received message” (see para. [0043] of Bandini). Even though the message “may be received from an internal site”, such receipt is still conducted over a local area network, wide area network, or other form of “email network” as is further shown in Figures 1 and 2 of Bandini (See also para. [0022] of Bandini).

Clearly, determining whether a message should “continue”, as is arguably disclosed in Bandini, does not suggest “*disabling an operable ability of the client to send the composed message*” as is further claimed in amended independent Claim 1. To reiterate, determining whether one of a plurality of alternative actions, such as deferring or quarantining a message already received in an “SMTP relay” 202, as arguably disclosed in Bandini (see para. [0037, 0050]), does not suggest “*disabling*” an ability of the “*client*”, much less “*disabling an operable ability of the client to send the composed message to the messaging system for sending to each recipient*” as is further claimed in amended independent Claim 1. The “dropping of the message”, after it is received at the email firewall, simply does not suggest “*disabling*” as it is further presented in amended independent Claim 1.

For at least these reasons, withdrawal of the previous rejection under 35 U.S.C. §103(a) is respectfully requested.

With this paper, independent **Claims 12, 21, and 30** have been amended to include limitations that are similar, albeit different, to that discussed above with regard to amended independent Claim 1. For at least the same reasons, the combination of Logan, Rhodes, and Bandini, does not suggest these limitations of these claims, especially when they are considered as a whole. Withdrawal of the previous rejection under 35 U.S.C. § 103(a) of these claims is therefore also respectfully requested.

So far as **Claims 2-3, 5, 7, 9-11, 13-14, 16, 18-20, 22-23, 25 and 27-29** depend respectively from amended independent base Claims 1, 12, and 21, these claims are not rendered obvious by the combination of Logan, Rhodes, and Bandini for at least the same reasons as

amended independent Claim 1. Withdrawal of the rejections of these claims under 35 U.S.C. § 103(a) is therefore respectfully requested for at least these same reasons.

Claims 6, 8, 15, 17, 24 and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Logan, in view of Rhodes, Bandini and further in view of Wilson, U.S. Patent Publication No. 2004/0015554 (hereinafter “Wilson”). **Claim 4** was rejected under 35 U.S.C. 103(a) as being unpatentable over Logan, in view of Rhodes, Bandini and further in view of Burrows et al., U.S. Patent No. 7,149,801 (hereinafter “Burrows”).

However, so far as **Claims 4, 6, 8, 15, 17, 24 and 26** depend respectively from amended independent base Claims 1, 12, and 21, these claims are not rendered obvious by the combination of Logan, Rhodes, and Bandini for at least the same reasons as amended independent Claim 1. None of the other references address the deficiencies of Logan, Rhodes, and Bandini noted above. Withdrawal of the rejections of these claims under 35 U.S.C. § 103(a) is therefore respectfully requested for at least these same reasons.

CONCLUSION

In view of the above amendment, applicant's representative believes the pending application is in condition for allowance.

Dated: April 3, 2009

Respectfully submitted,

By /john w branch/
John W. Branch
Registration No.: 41,633
DARBY & DARBY P.C.
P.O. Box 770
Church Street Station
New York, New York 10008-0770
(206) 262-8906
(212) 527-7701 (Fax)
Attorneys/Agents For Applicant